

REMARKS

Claims 1-28 are cancelled without prejudice to subsequent revival. New claims 29-38 are added. For convenience, the Examiner's rejections are addressed in the order presented in the January 21, 2003 Office Action.

**I. Status of the claims**

Claims 1-28 are cancelled without prejudice to subsequent revival. New claims 29-38 are added and are drawn to allowable subject matter identified by the Examiner in a previous Office Action.

The Examiner identified allowable subject matter in original claims 12 and 13. Because original claim 12 depended from both claims 1 and 2, the new claims incorporate the methods of both claims 1 and 2. New claims 29 and 33 are added and are directed to the methods of claims 1 and 2, respectively, using a locus-specific capture oligonucleotide that comprises SEQ ID NO:277. Claims 30-32 depend on claim 29; new claims 34-36 depend on claim 33. Independent claims 37 and 38 are drawn to the methods of claims 1 and 2, respectively, using a locus specific capture oligonucleotide that is selected from the group consisting of SEQ ID NOS:270-273 and SEQ ID NOS:275-277. Support for these amendments is found in the specification, for example, at page 6, lines 1-4; and in original claims 12 and 13.

**II. Rejections under 35 U.S.C. §102(b)**

Claims 1, 3, 4, 10, 14, and 15 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Kaneshige *et al.*, MHC & IRS Supplement to Vol. 1, 1994 pages 159-164. Claims 1-29 are now cancelled without prejudice to subsequent revival. New claims 29-38 are drawn to the method of claim 1 using specific capture oligonucleotides, *e.g.*, SEQ ID NO:277 or an oligonucleotide selected from the group consisting of SEQ ID

NOS:270-273 and SEQ ID NOS:275-277. In view of these amendments, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

### **III. Rejections under 35 U.S.C. §103(a)**

Claims are rejected over Nevinney-Stickel *et al.* in view of Kaneshige *et al.*; over Kaneshige *et al.* in view of Allen *et al.* and Erlich *et al.*; and over Erlich *et al.*

Claims 2, 3, 4, 5, 10, 14, and 15 are rejected as allegedly being obvious over Nevinney-Stickel *et al.* in view of Kaneshige *et al.* Claim 11 is rejected as allegedly obvious over Kaneshige *et al.* in view of Allen *et al.* and Erlich *et al.* Claims 1-15 are cancelled. In view of this amendment, Applicants respectfully request that the rejections over Nevinney-Stickel *et al.* in view of Kaneshige *et al.*, and over Kaneshige *et al.* in view of Allen *et al.* and Erlich *et al.* be withdrawn.

#### *Rejections under 35 U.S.C. §103(a) over Erlich et al.*

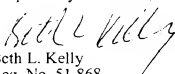
Claims 12 and 13 are rejected as allegedly obvious over Erlich *et al.* Applicants thank the Examiner for acknowledging that SEQ ID NO:277 is free of the prior art and identifying claims that require SEQ ID NO:277 as allowable. In response to the Examiner's invitation, Applicants have rewritten claims 12 and 13 as new claims 29-36 that require SEQ ID NO:277. The Office Action cited art that allegedly makes obvious the use of SEQ ID NO:274 as a capture oligonucleotide. Because the Office Action has not provided guidance as to how the search for prior art was conducted, Applicants also submit new claims 37 and 38 which require the following capture oligonucleotides: SEQ ID NOS:270-273 and SEQ ID NOS:275-277.

In view of the above amendments and remarks, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 415-576-0200.

Respectfully submitted,

  
Beth L. Kelly  
Reg. No. 51,868

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
BLK:blk  
SF 1453046 v2